

REMARKS/ARGUMENTS

The Office Action mailed September 6, 2007, has been received and reviewed. Claims 1 through 4, 6, 7, 9, 11 through 16, and 18 through 20 are currently pending in the application. Claims 9, 11 through 16, and 18 through 20 are withdrawn from consideration. Please note that Claim 17 has been canceled, not withdrawn as shown in the Office Action Summary. Claims 1 through 4, 6 and 7 stand rejected. Applicants have amended claims 1 and 4, and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection, or in the Alternative Obviousness Rejection, Based on European Patent No. 0878319 to Graumann et al.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, Graumann et al. (European Patent No 0878319). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The 35 U.S.C. § 102(b) anticipation rejections of claims 1 and 2 are improper because Graumann et al. does not describe each and every element of claims 1 and 2. Specifically, independent claim 1 has been amended to recite a print medium comprising an ink-receiving layer and an absorptive, coated paperbase selected from the group consisting of coated, calendered paper; coated, uncalendered paper and cast coated paper; the ink-receiving layer being present on the coated paperbase from about 3 grams per square meter to about 7 grams per square meter and comprising a cross-linking agent, and the coated paperbase having a Sheffield smoothness less than approximately 20 and a Sheffield porosity greater than zero and less than approximately 10. Graumann et al. does not describe use of an ink-receiving layer including a cross-linking agent. Claim 2 depends from and contains all of the limitations of claim 1.

In view of the proposed amendment to claim 1 and the foregoing arguments, Applicants respectfully request withdrawal of the present rejection.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Applicants' admission in their 131 Declaration

Claims 1 through 4, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admission in their 131 Declaration. Applicants respectfully traverse this rejection, as hereinafter set forth.

Specifically, the Examiner states that the papers filed by applicants admit that the base paper and the ink receptive coating were known. Even assuming such a statement to be true (which Applicants do not concede), the Examiner provides no support whatsoever for the proposition that it would have been obvious to one of ordinary skill in the art to coat the base paper with "an ink receptive composition at a conventional coating weight in order to obtain an ink receptive medium." (Office Action at pg. 2). This conclusion presumes that there is a "conventional coating weight" known in the art, which is an unsupported contention. Additionally, as discussed in the patent application at paragraph [0026] at page 12, the improved properties (lightfastness and humid color shift) observed in the print medium throughout the various examples in the application are due to the "thin coatweight and the absorptive paperbase used in the present invention." This "thin coatweight" is recited in claim 1 as being from about 3 grams per square meter to about 7 grams per square meter. There is no admission in the 131 Declaration that teaches or suggests that such coatweights were known in the art in combination with the other elements of the claims. As such, Applicants respectfully submit that the rejection based on the 131 Declaration is improper.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-4, 6 and 7, which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 1-4, 6 and 7.

Alternative Obviousness Rejection Based on European Patent No. EP0878319 to Graumann et al.

Claims 1 and 2 stand alternatively rejected under under 35 U.S.C. § 103(a) as being unpatentable over Graumann et al. (European Patent No 0878319). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1 and 2 are improper because Graumann et al. does not teach or suggest all of the claim limitations and, further, because Graumann et al. teaches away from the present invention.

As previously discussed, independent claim 1 has been amended to recite, inter alia, an ink-receiving layer being present on the coated paperbase from about 3 grams per square meter to about 7 grams per square meter and comprising a cross-linking agent. In contrast, Graumann et al. does not teach or suggest an ink-receiving layer that is present on the coated paperbase and which includes a cross-linking agent. Moreover, Graumann et al. teaches away from the present invention, as it teaches and claims an ink-absorbing coating that contains an uncrosslinked copolymer (I) of a quaternary ammonium compound and pyrrolidone, a polyvinyl alcohol and an aminomethacrylate (II). (Graumann et al. (translation) at Abstract, paragraph [0013], and claims). In view of the foregoing, Applicants respectfully request withdrawal of the present rejection to claim 1.

The nonobviousness of independent claim 1 precludes a rejection of claim 2, which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 1 and 2.

Obviousness Rejection Based on U.S. Patent No. 6,485, 812 to Sekiguchi, in view of European Patent No. 0878319 to Graumann et al.

Claims 1 through 4, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekiguchi (U.S. Patent No. 6,485,812), in view of Graumann et al. (European Patent No 0878319). Applicants respectfully traverse this rejection, as hereinafter set forth.

Sekiguchi is relied upon as generically describing certain particles and binders, along with a layer that may contain a cross-linking agent. However, as previously discussed, Graumann et al. teaches away from use of a cross-linking agent, as it teaches and claims an ink-absorbing coating that contains an uncrosslinked copolymer (I) of a quaternary ammonium compound and pyrrolidone, a polyvinyl alcohol and an aminomethacrylate (II). (Graumann et al. (translation) at Abstract, paragraph [0013], and claims). Therefore, there can be no motivation to combine the references where Graumann et al. expressly teaches away from use of a cross-linking agent in the ink-absorbing coating.

In view of the foregoing, Applicants respectfully request withdrawal of the present rejection to claim 1. The nonobviousness of independent claim 1 precludes a rejection of claims 2-4, 6, and 7, which depend therefrom.

Obviousness Rejection Based on U.S. Patent No. 6,485, 812 to Sekiguchi, in view of European Patent No. 0878319 to Graumann et al., and Further in View of U.S. Patent No. 6,780,924 to Shih et al. and U.S. Patent No. 6,777,039 to Koike et al.

Claims 1 through 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekiguchi (U.S. Patent No. 6,485,812), in view of Graumann et al. (European Patent No 0878319), and further in view of Shih et al. (U.S. Patent No. 6,780,924) and Koike et al. (U.S. Patent No. 6,777,039). Applicants respectfully traverse this rejection, as hereinafter set forth.

Sekiguchi is relied upon as generically describing certain particles and binders, along with a layer that may contain a cross-linking agent. Shih et al. is relied upon as teaching mordants in ink receptive layers. Koike et al. is relied upon as teaching polyvinyl alcohol as a binder and boron compounds to cross-link the binder. However, as previously discussed, Graumann et al. teaches away from use of a cross-linking agent, as it teaches and claims an ink-absorbing coating that contains an uncrosslinked copolymer (I) of a quaternary ammonium compound and pyrrolidone, a polyvinyl alcohol and an aminomethacrylate (II). (Graumann et al. (translation) at Abstract, paragraph [0013], and claims). Therefore, there can be no motivation to combine the cited references where Graumann et al. expressly teaches away from use of a cross-linking agent in the ink-absorbing coating.

In view of the foregoing, Applicants respectfully request withdrawal of the present rejection to claim 1. The nonobviousness of independent claim 1 precludes a rejection of claims 2-4, which depend therefrom.

Obviousness Rejection Based on U.S. Patent No. 6,485, 812 to Sekiguchi, in view of European Patent No. 0878319 to Graumann et al., and further in view of U.S. Patent No. 6,936,316 to Nigam et al.

Claims 1 through 3, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekiguchi (U.S. Patent No. 6,485,812), in view of Graumann et al. (European Patent No 0878319), as relied upon above, and further in view of Nigam et al. (U.S. Patent No. 6,936,316). Applicants respectfully traverse this rejection, as hereinafter set forth.

Sekiguchi is relied upon as generically describing certain particles and binders, along with a layer that may contain a cross-linking agent. Nigam et al. is relied upon as teaching inclusion of polyethylene oxide siloxane surfactants in ink-receptive layers. However, as previously discussed, Graumann et al. teaches away from use of a cross-linking agent, as it teaches and claims an ink-absorbing coating that contains an uncrosslinked copolymer (I) of a quaternary ammonium compound and pyrrolidone, a polyvinyl alcohol and an aminomethacrylate (II). (Graumann et al. (translation) at Abstract, paragraph [0013], and claims). Therefore, there can be no motivation to combine the references where Graumann et al. expressly teaches away from use of a cross-linking agent in the ink-absorbing coating.

In view of the foregoing, Applicants respectfully request withdrawal of the present rejection to claim 1. The nonobviousness of independent claim 1 precludes a rejection of claims 2, 3, 6, and 7, which depend therefrom.

ENTRY OF AMENDMENTS

The amendments to claims 1 and 3 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-4, 6, and 7 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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